

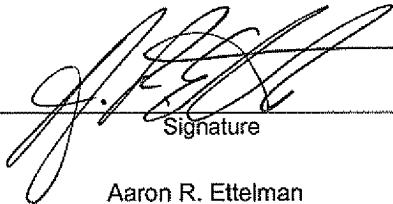
Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 13077-00098-US	
	Application Number 10/520,574-Conf. #5269	Filed July 15, 2005	
	First Named Inventor Lothar Puppe et al.		
	Art Unit 1621	Examiner C. O. Nwaonicha	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,516</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <div style="text-align: right;"> _____ Signature _____ Aaron R. Ettelman Typed or printed name _____ (302) 658-9141 Telephone number _____ January 16, 2008 Date</div>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

REMARKS ACCOMPANYING REQUEST FOR PRE-APPEAL BRIEF REVIEW

Claims 1-12 and 14-23 are currently pending in the instant application.

Status of the Claims:

In the Advisory Action dated November 16, 2007 (Paper No. 20071030, hereinafter referred to as “the Advisory Action”), the Examiner had indicated that **claims 1-12 are allowed**.

Claim 13 was canceled in Applicant’s Amendment after Final, which was filed on October 19, 2007, and which was indicated in the Advisory Action as having been entered.

Claims 14-23 stand rejected, as indicated in the Advisory Action, for the reasons of record set forth in the final Office Action dated July 19, 2007 (Paper No. 20070616, hereinafter referred to as “the final Office Action”). Claims 14-21 are rejected in the final Office Action under 35 U.S.C. §102(b), as being anticipated by each of U.S. Patent No. 3,630,954 of Yates (“Yates”), U.S. Patent No. 5,603,805 of Andersson, *et al.* (“Andersson”), and U.S. Patent No. 5,643,414 of Johansson, *et al.* (“Johansson”). These same rejections are apparently extended to claim 23 in the Advisory Action. Applicants respectfully request a Pre-Appeal Brief Conference Review of claims 14-23, withdrawal of the rejections and a Notice of Allowance based on the remarks which follow.

At the outset, Applicants would like to point out that **claim 22 is a process claim** directly dependent from allowed, independent claim 1. *Claim 22 was never previously rejected in conjunction with claims 14-21.* Accordingly, Applicants submit that the rejection of claim 22 in conjunction with the rejection of product claims 14-21 and 23 is an error, and that claim 22 should stand allowed along with claims 1-12. **Accordingly, at a minimum, in response to this paper, Applicants respectfully request withdrawal of the rejections with respect to claim 22, and allowance of claim 22 along with claims 1-12.**

Claims 14-21 and 23:

In the final Office Action and in Item 11 of the Advisory Action, the Examiner contends that claims 14-23 are product-by-process claims, and that because no patentable weight is given to the “process limitations thereof,” that the claims read on the prior art references and are thus properly rejected. **Applicants respectfully submit that the Examiner is plainly and factually incorrect. Claims 14-21 are NOT product-by-process claims.** Claims 15-21 depend from independent claim 14. Claim 14 reads as follows:

14. A silica sol having a BET surface area of from 100 to 1200 m²/g, wherein said silica sol comprises from 0.05 to 15% by weight of guanidinium ions, based on the total weight of the silica sol, wherein said silica sol is free of amine.

Claims 14-21 are product claims written without reference to process limitations. Claims 14-21 contain product claim elements not taught or suggested by the cited prior art references.

In fact, claim 23 is the only product-by-process claim pending in the instant application. However, Applicants note that claim 23 also contains express elements with respect to the product itself (and not with respect to any particular process step), which elements are not taught or suggested by the art.

More specifically, Applicants respectfully submit that claims 14 and 23 (and the claims depending from claim 14) are directed to silica sols having a specified BET surface area, a specified percent by weight content of guanidinium ions, **and which are free of amine.** The silica sol of claim 23 is prepared by the process of claim 1, but also requires a specified BET surface area, a specified percent by weight content of guanidinium ions, and is free of amine. **Applicants respectfully submit that the Examiner has failed to point to any specific teaching or suggestion in any of the cited references which discloses a silica sol having the claimed properties and which is free of amine.**

It is extremely well-settled that in order to support an anticipation rejection under 35 U.S.C. §102, each and every element of the claimed invention must be disclosed, either

explicitly or implicitly, in a single reference. The outstanding rejections of claims 14-21, as set forth in the final Office Action, are under 35 U.S.C. §102(b), as being anticipated by each of Yates, Andersson, and Johansson. Applicants respectfully submit that none of Yates, Andersson or Johansson teaches the claimed invention as set forth in claims 14-21 and 23 in a manner sufficient to support an anticipation rejection under 35 U.S.C. §102.

More specifically, none of Yates, Andersson or Johansson teaches a silica sol containing guanidinium ions **and which is free of amine**. The Examiner has failed to point to any teaching in any of the three references which discloses a silica sol free of amine and containing guanidinium ions. Moreover, even if the Examiner's "inherency" contentions concerning the claimed BET surface area, zeta potential, etc. were properly supported with the legally required rationale tending to show that the supposed teachings "*necessarily follow*" from the disclosure of the cited art, which they are not, **the references would still fail to teach or suggest the claimed presence of guanidinium ions and the absence of amine**.

Yates clearly discloses a sol comprising a co-stabilizer system which contains "...at least one amine selected from the group consisting of (1) compounds having the (amine) formula ..." (See, Yates, col. 1, line 69, through col. 2, line 23). Andersson and Johansson, which are commonly owned and which have an inventor in common, are directed to related subject matter and contain very similar disclosures. The Andersson/Johansson disclosures do not contain any references to a silica sol containing guanidinium ions. In fact, there does not appear to be any disclosure in either reference which is directed to the use or addition of any guanidine compound. The Examiner has not set forth any specific reference to a column or a line number location in either reference wherein the use of a guanidine compound is even mentioned.

Thus, Applicants respectfully submit that the Examiner is factually incorrect in asserting that pending claims 14-21 are product-by-process claims. Claim 23, which is the only product-by-process claim pending in the instant application, contains elements not taught or suggested in the cited art. None of the references described silica sols which contain guanidinium ions and which are free of amine.

Accordingly, Applicants respectfully submit that the anticipation rejections set forth in the final Office Action, and maintained in the Advisory Action with respect to claims 14-21 and 23, are improper. Accordingly, reconsideration and withdrawal of the rejections and a Notice of Allowance as to all pending claims are respectfully requested.